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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,058	10/26/2001	Michael Mulligan	NOKM.016PA	3896

7590 10/17/2006

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EXAMINER

CHANG, JUNGWON

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 10/17/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/036,058
Filing Date: October 26, 2001
Appellant(s): MULLIGAN, MICHAEL

Steve R. Funk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 7/21/06 appealing from the Office action mailed 8/24/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0013434	Rosenberg et al.	05-2003
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2003/0207685	Rankin	11-2003
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Scott Seely, "Web Service description and Discovery Using UDDI, Part II", Microsoft Corporation.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 8-31, 33-35, 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg et al. (2003/0013434), hereinafter Rosenberg.

3. As to claims 1, 24 and 38, Rosenberg discloses the invention as claimed, including a method for provisioning mobile terminals (wireless device, 30, fig. 1; 38, fig. 2) (page 1, [0011]; page 2, [0014]-[0015]) for use of applications offered by one or more network services on a network (access web pages and other Internet content on a network; page 1, [0008]; page 2, [0015]), comprising:

interfacing at least one mobile terminal wireless device (30, fig. 1; 38, fig. 2; page 3, [0044]) to at least one network service (Internet service, 32, 33, fig. 1; 37, fig. 2) via a provisioning Web service (automatically activating wireless services on a wireless device; page 1, [0001]; page 2, [0013], [0017]; automatically provisioning wireless services on a wireless device; page 2, [0019], [0020]), wherein the provisioning Web service is implemented using Web Services (wireless service provider to enable a wireless device user to select a wireless service plan on a web site; page 2, [0015]) and provides a single point of interface to the network service (37, fig. 2) for provisioning the mobile terminal (activation process; page 1, [0011]; page 2, [0014]-[0015]; provisioning wireless services on a wireless device; page 2, [0019]) and

provisioning the mobile terminal by the provisioning Web service for use of at least one application provided by the network service (email application; page 2, [0025]; page 3, [0027]), wherein the provisioning comprises configuring the mobile terminal for use of the application (depending on the type of wireless device; page 7, [0087]; wireless device may be any wireless device capable of accessing voice, data, and Internet content...wireless device may be equipped with Internet access software; page

4, [0051]) and delivering the application to the mobile terminal (transmits the web pages and other Internet content to wireless devices; page 3, [0046]).

4. As to claims 2 and 3, Rosenberg discloses establishing a network connection between the network service (Internet service, 32, 33, fig. 1; 37, fig. 2) and a Web services endpoint (web server; 50, fig. 4) associated with the provisioning Web service, which terminates Web service protocols (Internet protocol; page 5, [0060]).

5. As to claim 8, Rosenberg discloses delivering the application via a data object delivery module of the provisioning Web service (transmits the web pages and other Internet content to wireless devices; page 3, [0046]).

6. As to claims 9-13, Rosenberg discloses comparing data object variants offered by the application with a terminal type of the mobile terminal to determine a suitable data object to deliver for the terminal type of the mobile terminal (device-specific information; page 2, [0023]).

7. As to claims 14-18, Rosenberg discloses sending appropriate configuration settings to the mobile terminal comprises sending the configuration settings to the mobile terminal via a terminal management server (wireless service provider registers the wireless device on user databases, servers and system; page 1, [0011]; page 2, [0014]-[0015]).

8. As to claims 19 and 20, Rosenberg discloses Internet or Intranet (31, 32, fig. 1).

9. As to claim 21, it is rejected for the same reasons set forth in claim 1, 24 and 38 above. In addition, Rosenberg discloses Web service data object delivery module coupled to the Web service interface to deliver the applications to successfully configured mobile terminals as part of the provisioning procedures (transmits the web pages and other Internet content to wireless devices; page 3, [0046]).

10. As to claims 22 and 23, Rosenberg discloses Web service interface, Web service mobile terminal configuration module (wireless service provider registers the wireless device on user databases, servers and system; page 1, [0011]; page 2, [0014]-[0015]), and Web service data object delivery module (transmits the web pages and other Internet content to wireless devices; page 3, [0046]).

11. As to claims 30 and 33-35, Rosenberg discloses terminal management module to configure the application use settings on the mobile terminal to allow connectivity of the mobile terminal to the network service (device-specific information; page 2, [0023]; depending on the type of wireless device; page 7, [0087]; wireless device may be any wireless device capable of accessing voice, data, and Internet content...wireless device may be equipped with Internet access software; page 4, [0051]).

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12. As to claim 31, Rosenberg further discloses a cache for storing the application (database; 53, 54, fig. 4).

13. As to claim 39, it is rejected for the same reasons set forth in claims above. In addition, Rosenberg discloses a computer-readable medium having computer-executable instructions for provisioning mobile terminals (fig. 3; 50, fig. 4).

14. As to claims 25 and 26, they are rejected for the same reasons set forth in claims 2 and 3 above.

15. As to claims 27-29, it is rejected for the same reasons set forth in claims 9-13 above.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg et al. (2003/0013434), in view of Scott Seely "Web Service description and Discovery Using UDDI, Part II", Microsoft Corporation.

18. Seely was cited by examiner on PTO-892 in the prior office action dated 10/22/2003.

19. As to claims 4-7, Rosenberg does not specifically disclose the Simple Object Access Protocol (SOAP), UDDI, and WSDL. However, Rosenberg discloses one or more of a wide variety of communication protocols (col. 6, lines 20-23). Seely discloses UDDI (fig. 1; page 1) and SOAP (page 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Moles and Seely because the SOAP is known as a XML based protocol (i.e., communication protocol) that provides the Internet Web service.

20. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg et al. (2003/0013434), Scott Seely, further in view of Rankin (2003/0207685).

21. As to claim 32, Rosenberg discloses notifying the mobile terminal that the application is available at the data object deliver module (device-specific information; page 2, [0023]; depending on the type of wireless device; page 7, [0087]; wireless device may be any wireless device capable of accessing voice, data, and Internet content...wireless device may be equipped with Internet access software; page 4, [0051]). However, Rosenberg and Seely do not specifically disclose if the mobile

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terminal is not capable of direct delivery receipt by the data object delivery module and to provide an address of the application at the data object delivery module. Rankin discloses if the mobile terminal is not capable of direct delivery receipt by the data object delivery module and to provide an address of the application at the data object delivery module (page 3, [0038]; page 4, claims 8, 17 and 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rosenberg, Seely and Rankin because Rankin's determining the mobile terminal is not capable to receive the data would improve quality of service of Rosenberg's system by allowing the network service provider to aware of capability of mobile terminal prior to transmission the data.

22. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg et al. (2003/0013434), in view of Rankin (2003/0207685).

23. As to claim 37, it is rejected for the same reasons set forth in claims 1, 8, 14-18, 24 and 38 above. In addition, Rosenberg discloses notifying the mobile terminal that the application is available at the data object deliver (device-specific information; page 2, [0023]; depending on the type of wireless device; page 7, [0087]; wireless device may be any wireless device capable of accessing voice, data, and Internet content...wireless device may be equipped with Internet access software; page 4, [0051]). However, Rosenberg does not specifically disclose if the mobile terminal is not capable of direct delivery receipt by the data object delivery and to provide an address of the application

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at the data object delivery. Rankin discloses if the mobile terminal is not capable of direct delivery receipt by the data object delivery and to provide an address of the application at the data object delivery (page 3, [0038]; page 4, claims 8, 17 and 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rosenberg and Rankin because Rankin's determining the mobile terminal is not capable to receive the data would improve quality of service of Rosenberg's system by allowing the network service provider to aware of capability of mobile terminal prior to transmission the data.

(10) Response to Argument**A. The rejection under 35 U.S.C. 102(e) of Claims 1-3, 8-31, 33-35, 38 and 39.**

Appellant's Argument: Applicant asserts that Rosenberg does not teach at least the claimed provisioning Web service implemented using Web services.

Examiner's response: The examiner respectfully disagrees. The examiner finds that as described on page 16, line 15 – page 17, line 4 of the specification of the present application, provisioning Web service (300, fig. 3; 400, fig. 4) includes a transport layer server, such as an HTTP server (406, fig. 4). Thus, the Examiner is correct in the interpretation that wireless service provider (50, fig. 4), which includes a web server (HTTP server; 51, fig. 4) has the same function as claimed provisioning Web service. Therefore, Rosenberg explicitly discloses provisioning Web service implemented using Web services (50, 51, fig 4; page 5, 0066-0067) (page 2, 0019,

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“automatically provisioning wireless services on a wireless device...the wireless services may include cellular phone service, e-mail, Internet access, games, financial trading, and location-aware services”; page 2, 0013-0014, ***“automatically activating wireless services on multiple wireless devices”*** page 4, 0050; page 5, 0066-0067).

Appellant's Argument: Applicant asserts that Rosenberg does not teach or suggest using a provisioning web service implemented by web services to provision a mobile device.

Examiner's response: The examiner respectfully disagrees. Once again, as described on page 16, line 15 – page 17, line 4 of the specification of the present application, provisioning Web service (300, fig. 3; 400, fig. 4) includes a transport layer server, such as an HTTP server (406, fig. 4). Thus, the Examiner is correct in the interpretation that wireless service provider (50, fig. 4), which includes a web server (HTTP server; 51, fig. 4) has the same function as claimed provisioning Web service. Therefore, Rosenberg explicitly discloses using a provisioning web service implemented by web services (50, 51, fig 4; page 5, 0066-0067) to provision a mobile device (30a-e, fig. 1, “wireless device”; page 3, 0044) (page 2, 0019, ***“automatically provisioning wireless services on a wireless device...the wireless services may include cellular phone service, e-mail, Internet access, games, financial trading, and location-aware services”***; page 2, 0013-0014, “automatically activating wireless services on multiple wireless devices”; page 4, 0050; page 5, 0066-0067).

Appellant's Argument: Applicant asserts that the rejection of dependent claims 2-3, 8-20, 22-23, 25-31 and 33-35 is improper.

Examiner's Response: Claims 1, 21 and 24 are properly rejected under 35 U.S.C. 102(e). Therefore, claims 2-3, 8-20, 22-23, 25-31 and 33-35 are properly rejected under 35 U.S.C. 102(e), for the same reasons.

B. The rejection under 35 U.S.C. 103(a) of dependent claims 4-7

Appellant's Argument: Applicant asserts that Rosenberg at least fails to teach provisioning a mobile terminal by a provisioning Web service implemented using Web services because Rosenberg teaches provisioning a terminal manually.

Examiner's Response: as argued in detail above, Rosenberg explicitly discloses provisioning a mobile terminal by a provisioning Web service implemented using Web services. Furthermore, claims do not recite provisioning a terminal *automatically*.

Appellant's Argument: Applicant asserts that there is no suggestion or motivation in Rosenberg to modify an activation module to provision a terminal via a network using Web services.

Examiner's Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

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found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, modifying Rosenberg by using protocols (SOAP, UDDI, WSDL), as taught by Seely would allow the user to self initiating the web service (page 1, "Registering yourself with UDDI; page 6, "Defining the services").

Appellant's Argument: Applicant asserts that the rejection of dependent claim 5 is improper.

Examiner's Response: Claim 5 is rejected under 35 U.S.C 103(a) as being unpatentable over Rosenberg, in view of Seely. Rosenberg discloses a service point (51, fig. 4, web server) with a service registry (figs. 7-13) to advertise the provisioning web service (51, fig. 4, "activation web server"; figs. 7-13; page 6, 0078-0079).

Rosenberg does not specifically use a term "web service endpoint". Seely explicitly use the term "web service endpoint" (page 7, Finding the data section, and summary section, "web service endpoints"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Rosenberg and Seely because Seely's web service endpoint would allow the user to look the web service through the web service endpoint (Seely, page 7, Summary).

Appellant's Argument: Applicant asserts that the rejection of dependent claim 7 is improper.

Examiner's Response: Claim 7 is rejected under 35 U.S.C 103(a) as being unpatentable over Rosenberg, in view of Seely. Rosenberg discloses enabling the application to initiate requests to provision the mobile terminals via the service point (51, fig. 4, web server) (page 4, 0057, "activation web server 40 handles all the requests submitted"; page 5, 0062). Rosenberg does not specifically use a term "web service endpoint". Seely explicitly use the term "web service endpoint" (page 7, Finding the data section, and summary section, "web service endpoints"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Rosenberg and Seely because Seely's web service endpoint would allow the user to look the web service through the web service endpoint (Seely, page 7, Summary).

C. The rejection under 35 U.S.C. 103(a) of dependent claim 32

Appellant's Argument: Applicant asserts that Rosenberg and Seely at least fail to teach provisioning a mobile terminal by a provisioning Web service implemented using Web services because Rosenberg teaches provisioning a terminal manually and Seely is silent on provisioning.

Examiner's Response: In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As noted in the Final Office action, the Examiner relies

on Seely only to teach a plurality of protocols.

As stated in detail above, Rosenberg explicitly teaches provisioning Web service implemented using Web services. What Rosenberg fails to specifically disclose is a plurality of protocols. Seely is relied upon to teach this limitation of the claim.

Appellant's Argument: Applicant asserts that Rankin does not teach provisioning a mobile terminal by a provisioning Web service implemented using Web services. Therefore, the asserted combination of Rosenberg, Seely, and Rankin fails to teach or suggest provisioning a mobile terminal by a provisioning Web service implemented using Web services.

Examiner's Response: In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As noted in the Final Office action, the Examiner relies on Rankin is relied upon only to teach if mobile terminal is not capable of direct delivery receipt by the data object delivery module and to provide an address of the application at the data object delivery module.

As argued in detail above, Rosenberg explicitly teaches provisioning Web service implemented using Web services. What Rosenberg fails to specifically disclose is if the mobile terminal is not capable of direct delivery receipt by the data object delivery module and to provide an address of the application at the data object delivery module.

Rankin is relied upon to teach this limitation of the claim 32 (Rankin, page 3, [0038]; page 4, claims 8, 17 and 18).

D. The rejection under 35 U.S.C. 103(a) of independent claim 37

Appellant's Argument: Applicant asserts that nowhere Rankin describe providing an address of a data delivery module if a terminal is not capable of direct delivery receipt.

Examiner's Response: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *providing* an address of a data **delivery module**) are not recited in the rejected claim 37. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Rankin explicitly discloses providing an address of a data object (data inherently includes IP address or URL) if a terminal is not capable of direct delivery receipt (data received from the web server inherently includes URL or IP address; page 1, 0011, "portable communications device may further comprise means configured to determine whether a respective user terminal is available to receive data from the said server, if so, to forward such data and, if not, to buffer, 18A, such data until such time as either the respective user terminal becomes available"; page 3, 0038, "the service may comprise a telecommunications or web-based service or some other arrangement for information delivery dependent on the capabilities of the mobile device 18").

Appellant's Argument: Applicant asserts that neither Rosenberg nor Rankin provides motivation to combine the references as asserted.

Examiner's Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rosenberg by providing an address of a data object if a terminal is not capable of direct delivery receipt would allow the mobile terminal to keep receive the data sent from the server even though the mobile terminal is unavailable, as taught by Rankin (page 1, 0011, "portable communications device may further comprise means configured to determine whether a respective user terminal is available to receive data from the said server, if so, to forward such data and, if not, *to buffer, 18A, such data until such time as either the respective user terminal becomes available*"; page 2, 0018).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

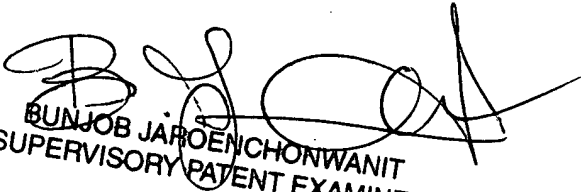
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